

REMARKS

Claims 1-28 stand rejected. Claims 1-28 are presently pending. Claims 1, 4, 6, 11, 13, 14, 17, 18, 21, 22,23, and 26 have been amended. No new matter has been added. The amendments are supported by the original specification and figures. In view of the foregoing amendments and the following remarks, Applicant respectfully submits that all of the presently pending claims are allowable. Reconsideration of the Application is respectfully requested.

1. Rejection of claims 21-23 and 26 (35 USC § 112)

Claims 21-23 and 26 were rejected under 35 U.S.C. § 112, first paragraph, the Examiner alleging they do not comply with the written description requirement. Although the rejection may not be agreed with, in order to facilitate prosecution, claims 21-23 have been amended to clarify the claimed subject matter. The claims as amended are supported by the original specification, e.g., by paragraph 0020 and Fig.2B. Applicant submits that the amended claims 21-23 are therefore in allowable condition.

Claim 26 recites “The gaming slip of claim 6, wherein all the games corresponding to each of the game panels are simultaneously played.” In the Office Action mailed January 25, 2005, the Examiner stated that “there is no disclosure in the specification that all of the games recites in claim 6 are simultaneously played.” While the rejection may be disagreed with, in order to expedite prosecution, the claim has been amended to clarify the claimed subject matter. Applicant submits that claim 26 is fully supported by the original specification (see e.g. paragraph 0020).

In view of the foregoing amendments, Applicant submits that claims 21-23 and 26 are allowable and respectfully requests withdrawal of the rejections under 35 U.S.C. § 112.

2. Rejection of claims 1, 3-5, 8-10, 13, 16, 17, 20, 24 and 25 (35 U.S.C. § 102(b))

Claims 1, 3-5, 8-10, 13, 16, 17, 20, 24 and 25 stand rejected under 35 U.S.C. § 102(b), the Examiner alleging these claims are anticipated by U.S. Patent No. 5,249,801 to Jarvis (“Jarvis”). While Applicant disagrees with the rejection, upon grounds discussed in Amendment A, claims 1, 13 and 17 have been amended to clarify the presently claimed subject matter.

To anticipate a claim under § 102(b), a single prior art reference must identically disclose each and every claim element. M.P.E.P. § 2131. Claim 1, as currently amended, recites “the gaming information including a random request region corresponding to a game, wherein the random request region enables a plurality of computer-generated picks to be requested for the game to be requested.” As discussed in the previous Amendment A, Jarvis generally describes a lottery playing card having rows or arrays of numbers. The numbers can be circled by a player to identify a game selection, for example a set of numbers. The player can also automatically select a single random set of numbers without actually having to pick his or her own numbers by filling in box 26. The “easy pick” box 26 described by Jarvis allows a player to select only one pick for one game. Even when several elements 26 are combined into a single object, as argued by the Examiner Jarvis still does not teach or suggest “a random request region corresponding to a game” because each of elements 26 corresponds to a distinct or different game. See Jarvis, col.3, lines 8-11. Thus there is no random request region which allows the selection of a plurality of picks for a game. Accordingly, claim 1 as amended is not anticipated by Jarvis.

Similar arguments apply to independent claims 13 and 17 which have been similarly amended. Thus, Applicant respectfully submits that Claims 1, 13 and 17 should be allowable over Jarvis. Claims 3-5, 8-10, 16, 20, 24 and 25 being each dependent on one of Claims 1, 13 and 17, Applicant submits that Claims 3-5, 8-10, 16, 20, 24 and 25 are allowable for at least the same reasons as their respective parent claims. Withdrawal of the rejection is respectfully requested.

3. Rejection of claims 2, 6, 7, 11, 12, 14, 15, 18, 19 and 27 (35 U.S.C. § 103(a))

Claims 2, 6, 7, 11, 12, 14, 15, 18, 19 and 27 stand rejected under 35 U.S.C. § 103(a), the Examiner alleging that these claims are unpatentable over Jarvis in view of U.S. Patent No. 5,158,293 to Mullins (“Mullins”). Applicant respectfully submits that the rejections should be withdrawn for at least the following reasons.

First, Claims 2, 6, 7, 14, 15, 18, 19 and 27 each depend on one of Claims 1, 13 and 17. Therefore, these claims should be allowable for at least the reasons given above for their respective parent claims.

Second, to establish a prima facie case of obviousness under 35 U.S.C. § 103(a), the prior art references must teach or suggest all the claim limitations. M.P.E.P. § 2143.03. Claim 2 recites “a plurality of random request regions, each random request region corresponding to a different type of game”. Applicant respectfully submits that the combination of Jarvis and Mullins fails to disclose this limitation of claim 2.

Mullins generally describes a lottery ticket with two halves, one for an instant lottery, and one for a future draw lottery. The player may use the first half to play a scratch-off type game as soon as he or she buys the ticket, and hold on to the second half to play a future draw lottery. Mullins does not teach or suggest combining two different future draw lotteries and does not provide a plurality of random request regions as recited in Applicant’s claim 2. Therefore, Applicant submits that the recited limitation is not in either reference, nor in their combination. Therefore, claim 2 is not obvious over the proposed combination, and should be allowable.

Claim 11, as currently amended, recites “a random request region for the respectively corresponding game, the random request region enabling a plurality of computer-generated picks to be requested for the respectively corresponding game”. Based on the discussion regarding claims 1, 13 and 17 above, Applicant submits that neither Jarvis nor Mullins teach or suggest this limitation of claim 11. Therefore, Applicant submits that claim 11 is not obvious, and should be allowable.

Separately and independently with respect to both claims 2 and 11, the Applicant respectfully submits that the Examiner has failed to provide a proper motivation to combine Jarvis and Mullins. The Examiner's reasoning that the motivation to combine is to allow Jarvis's player to participate in different types of games is a hindsight reconstruction that has used the Applicant's claimed invention as a roadmap to pick and choose features from the cited references. To reject, the Examiner must find a suggestion to combine the references that is "clear and particular". *In re Dembicza*k, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999). The requirement is for "actual evidence" of the proposed motivation to combine. *Teleflex, Inc. v. Ficosa North America Corp.*, 299 F.3d 1313, 1334, 63 USPQ2d 1374 (Fed. Cir. 2002). Because no proper motivation to combine has been provided, Applicant respectfully submits the obviousness rejection should be withdrawn.

In the Office Action mailed January 25, 2005, the Examiner apparently asserted that the rejection was proper since hindsight reasoning was not based on knowledge gleaned only from the applicant's disclosure, and that motivation to combine was provided by the prior art. Applicant respectfully traverses both contentions. Mullins discloses that "[o]ne of the problems with many of the lottery games already known is that they allow the player only one play for each ticket purchased." This statement applies to *tickets* as shown in Fig. 1 to 5 of Mullins. Thus Mullins might arguably teach a lottery game where tickets include multiple games. However, nothing in Mullins teaches or suggests to have a play slip that allows multiple random or "quick picks" for a single game as recited in Applicant's claims.

Mullins deals with tickets. Jarvis deals with play slips. These two entirely types of apparatus in the gaming arts. Jarvis' play slips are a type of entry device to allow players to indicate desired gaming purchases. Mullins' ticket is a receipt or objects for game play. Nothing about Mullins would lead an ordinary artisan in the gaming arts to modify the play slips of Jenkins in the manner described by the Examiner. Therefore a person with ordinary skills in the art would not combine Mullins with Jarvis since they refer to different problems.

For at least the foregoing reasons, Applicant submits that claims, 2, 6, 7, 11, 12, 14, 15, 18, 19, and 27 are allowable and respectfully request withdrawal of all rejections.

4. Rejection of claim 28 (35 U.S.C. § 103(a))

Claim 28 stands rejected under 35 U.S.C. § 103(a), the Examiner alleging that this claim is unpatentable over Jarvis. Applicant traverses and respectfully submits that the rejection should be withdrawn for at least the following reasons. Claim 28 depends on claim 1, and it should be allowable for at least the reasons given above for claim 1.

For at least the foregoing reasons, Applicant submits that claim 28 is allowable and respectfully requests withdrawal of the rejection.

CONCLUSION

In view of the above amendments and remarks, it is respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

The Office is authorized to charge any fees associated with this Amendment to Kenyon & Kenyon Deposit Account No. 11-0600.

Respectfully Submitted,

KENYON & KENYON

Dated: May 25, 2005

By: 

Andrew L. Reibman
(Reg. No. 47,893)

One Broadway
New York, NY 10004
(212) 425-7200

CUSTOMER NO. 26646